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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|----------------------------|------------------|
| 10/782,387 | 02/18/2004 | J. Michael Rivera | 022050-000100US | 4345 |
| 20350 | 7590 | 03/09/2007 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP | | | BATTULA, PRADEEP CHOURDARY | |
| TWO EMBARCADERO CENTER | | | ART UNIT | PAPER NUMBER |
| EIGHTH FLOOR | | | 3722 | |
| SAN FRANCISCO, CA 94111-3834 | | | | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/782,387 | RIVERA ET AL. | |
| | Examiner | Art Unit | |
| | Pradeep C. Battula | 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 December 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This action is in Response to amendment filed on December 8, 2006

Allowable Subject Matter

The indicated allowability of claim 2 – 6, 9 – 13, 15 – 19, and 21 – 24 is withdrawn in view of the newly discovered reference(s) to Tarumi, Scarbrough, Roth and Howland. Rejections based on the newly cited reference(s) are followed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Osamu (JP 7,299,955 A).

In regards to Claim 1, Osamu discloses a method of attaching a hologram film to printed matter, comprising: printing a pattern on a substrate 3 with UV curable ink (Section 0005, Lines 1 – 10); placing a holographic film (5, 8) over said pattern (Section 0005, Lines 13 – 16); and curing said UV curable ink 4 with UV light (Section 0010, Lines 1 – 4; Generally known in art that UV ink is hardened by light; Section 0010, Lines 5 – 15; also cured with heat rollers); wherein said curing causes said holographic film to stick to said pattern (Section 0010, Lines 5 – 15; Figure 1, Item 5; Figure 2, Items 2, 4, 8).

In regards to Claim 14, Osamu discloses a security label comprising: a substrate 3 (Section 007, Lines 14 – 21); a pattern of UV cured ink 4 on said substrate (Section 0005, Lines 1 – 10; Figure 1, Items 3, 4); and a holographic film (5,8) over said pattern (Section 0005, Lines 13 – 16), adhering to the cured ink of said pattern (Section 0010, Lines 5 – 15; Figure 1, Item 5; Figure 2, Items 2, 4, 8).

In regards to Claim 19, as applied to Claim 14, Osamu further discloses wherein said UV cured ink has low adhesion properties (Section 0009, Lines 1 – 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2 – 4, 15 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu in view of Howland et al.(Howland; U.S. 6,089,614).

In regards to Claims 2 – 4, as applied to Claim 1, Osamu does not disclose wherein the UV curable ink has fluorescent, photo chromic, or thermo chromic properties.

Howland discloses a security device in which indicia that can be printed with UV curable ink (Column 7, Lines 19 – 21). Howland further discloses indicia as first and second indicia 7, 9 that can have thermo chromic, photo chromic, and fluorescent properties (Column 8, Lines 12 – 18). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV

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curable ink with various properties because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In regards to Claims 15 – 17, as applied to Claim 14, please refer to the rejection for Claims 2 – 4.

3. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu in view of Roth (U.S. 5,889,084).

In regards to Claim 5, as applied to Claim 1, Osamu does not disclose the UV curable ink has bi-chromic properties.

Roth discloses that it is well known in the art to have a UV curable ink that changes color, therefore having bi-chromic properties (Column 2, Lines 33 – 38). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a UV curable ink with bi-chromic properties because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In regards to Claim 18, as applied to Claim 14, please refer to the rejection for Claim 5.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu in view of Scarbrough et al. (Scarbrough; U.S. Pub 2004/0140665).

In regards to Claim 6, as applied to Claim 1, Osamu does not disclose wherein the UV curable ink is scratch-off ink.

Scarborough discloses an image with an illusion of three dimensions using opaque ink which is UV curable (Paragraph 0064, Lines 12 – 20). It is known to one with ordinary skill in the art that many opaque inks are scratch off. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with that is scratch off because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

5. Claim 7, 8, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu in view of Tarumi et al. (Tarumi; U.S. 5,631,107)

In regards to Claims 7 and 8, Osamu discloses a method of attaching a hologram film to printed matter comprising: printing a pattern on a substrate 3 with UV curable ink 4 (Paragraph 0005, Lines 1 – 10); placing adhesive 5b over said pattern (Section 0012, Lines 1 – 10); placing a holographic film 5a over said adhesive layer (Figure 1, Items 5a, 5b).

Osamu does not disclose placing a transparent UV curable adhesive layer over said pattern and curing said UV curable adhesive layer with UV light; wherein said curing causes said holographic film to stick to said adhesive layer.

Tarumi discloses a UV curing a transparent optical adhesive 11 for sticking a optical sheet, which can be a hologram film, onto a support plate 31 where the adhesive is treated to stick to the optical sheet 2 to a support plate (Column 4, Lines 44 – 55; Column 8, Lines 57 – 67 – Column 9, Lines 1 – 3 and 23 – 30; Figure 6, Items 2, 11, 31). Therefore it would have been obvious to a person having ordinary skill in the art at

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the time the invention was made to use Tarumi's adhesive and foil in order to allow for the ink, adhesive, and film be cured and fastened together in one ultraviolet curing step.

In regards to Claim 13, as applied to Claim 8, Osamu modified by Tarumi further discloses said UV cured ink has low adhesion properties (Section 0009, Lines 1 – 6; Osamu).

In regards to Claim 20, Osamu discloses a security label comprising: a substrate 3; an ink pattern 4 printed on said substrate (Paragraph 0005, Lines 1 – 10); and adhesive 5b over said pattern (Section 0012, Lines 1 – 10); a holographic film 5a over said adhesive layer, said film adhering to said adhesive layer (Figure 1, Items 5a, 5b).

Osamu does not disclose a transparent UV cured adhesive layer over said pattern of ink.

Tarumi discloses Tarumi discloses a UV curing a transparent optical adhesive 11 for sticking a optical sheet, which can be a hologram film, onto a support plate 31 where the adhesive is treated to stick to the optical sheet 2 to a support plate (Column 4, Lines 44 – 55; Column 8, Lines 57 – 67 – Column 9, Lines 1 – 3 and 23 – 30; Figure 6, Items 2, 11, 31). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Tarumi's adhesive and foil in order to allow for the ink, adhesive, and film be cured and fastened together in one ultraviolet curing step.

6. Claims 9 – 11 and 21 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu in view of Tarumi and Howland.

In regards to Claims 9 – 11, as applied to Claim 8, Osamu modified by Tarumi does not disclose wherein the UV curable ink has fluorescent, photo chromic, or thermo chromic properties.

Howland discloses a security device in which indicia that can be printed with UV curable ink (Column 7, Lines 19 – 21). Howland further discloses indicia as first and second indicia 7, 9 which can have thermo chromic, photo chromic, and fluorescent properties (Column 8, Lines 12 – 18). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with various properties because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In regards to Claims 21 – 23, as applied to Claim 20, please review the rejection for Claims 9 – 11.

7. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osamu in view of Tarumi and Scarbrough.

In regards to Claim 12, Osamu modified by Tarumi does not disclose the UV curable ink has bi-chromic properties.

Scarbrough discloses an image with an illusion of three dimensions using opaque ink which is UV curable (Paragraph 0064, Lines 12 – 20). It is known to one with ordinary skill in the art that many opaque inks are scratch off. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with that is scratch off because it has been held to

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be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In regards to Claim 24, as applied to Claim 20, please review the Claim 12 rejection.

Response to Arguments

Applicant's arguments with respect to claims 1, 7, 8, 14, and 20 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
February 15, 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER